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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,586	08/09/2001	Amado Nassiff	BOC9-2000-0032(178)	2981
40987	7590	05/23/2007		
AKERMAN SENTERFITT P. O. BOX 3188 WEST PALM BEACH, FL 33402-3188			EXAMINER BROADHEAD, BRIAN J	
			ART UNIT 3661	PAPER NUMBER
			MAIL DATE 05/23/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/925,586

Applicant(s)

NASSIFF ET AL.

Examiner

Brian J. Broadhead

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 19 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite the limitation "the at least one destination corresponding to at least one of a lodging, dining establishment, predetermined sightseeing attraction, road hazard, and detour." This limitation is not supported by the disclosure and doesn't really make sense. Why would a road hazard or detour be a destination?

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 19 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since

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the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 19 and 26 recite the broad recitation "at least one of a lodging, dining establishment, predetermined sightseeing attraction", and the claim also recites "as well as trip information indicating location locations or and information pertaining to dining establishments, predetermined sightseeing attractions, and lodging accommodations" which is the narrower statement of the range/limitation. The first recitation only requires "one of" while the second recitation appears to require all three types of locations.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 19 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palomo et al., 6405126, in view of Rennard et al., 6405123, and in further view of Ashby et al., 6173277.

3. Palomo et al. disclose a computing device remote from a vehicle on lines 5-7, on column 6; identifying navigation information for at least one destination (102) in response to a user input specifying a trip itinerary, the at least one destination corresponding to at least one of a lodging, dining establishment, predetermined sightseeing attraction, road hazard, and detour, each identified within said web site in response to and based on the specified trip itinerary on lines 20-30, on column 8, and figure 5; automatically determining navigation information for the destination, wherein at least a portion of the navigation information includes geographic coordinates for the destination as well as trip information indicating locations of and information pertaining to dining establishments, predetermined sightseeing attractions, and lodging accommodations corresponding to the user specified trip itinerary on lines 18-29, on column 6, lines 20-30, on column 8, and figure 5; storing the navigation information in at least a first memory remote from the vehicle on lines 30-35, on column 6; the location data is stored on a portable storage media, the portable storage media being transferred to the vehicle to transfer the navigation information to the navigation device in the vehicle on lines 60-65, on column 2; transferring the navigation information from the first memory to a navigation device in the vehicle on lines 37-38, on column 6.

4. Palomo et al. do not disclose the computing device accesses a publicly accessible web site; determining whether a data format of said navigation information

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conforms to data requirements of said in-vehicle navigation device prior to transferring, and converting the data format to an alternate data format prior to transferring said navigation information if said data format does not conform to data requirements of the in-vehicle navigation device. Rennard et al. teach the identifying step is performed on a web site on lines 4-34, on column 11. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the web site of Rennard et al. in the invention of Palomo et al. because such modification would provide an improved operating environment that allows a user to input complex information through alternative devices ahead of time as stated on lines 15-17, on column 11, of Rennard et al.

5. Palomo et al. and Rennard et al. do not disclose determining whether a data format of said navigation information conforms to data requirements of said in-vehicle navigation device prior to transferring, and converting the data format to an alternate data format prior to transferring said navigation information if said data format does not conform to data requirements of the in-vehicle navigation device. Ashby et al. teach determining whether a data format of said navigation information conforms to data requirements of said in-vehicle navigation device prior to transferring, and converting the data format to an alternate data format prior to transferring said navigation information if said data format does not conform to data requirements of the in-vehicle navigation device in lines 30-60, on column 3. It would have been obvious to one of ordinary skill in the art at the time the invention was made to check the format and

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convert it if necessary because it is instantly obvious. The system wouldn't work and it would be immediately obvious.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 19 and 26 have been considered but are moot in view of the new ground(s) of rejection. Upon further review of Palomo et al. it has become apparent that they do disclose lodging and dining establishments as shown in figure 5 and described as intended destinations. This makes Nakamura unnecessary as part of the rejection and renders the arguments moot. The amendment has raised new issues by making the claims unclear as to their scope. In referring to dining establishments, etc. in the third limitation of claim 19 by using "at least one of" they are not all required by the invention. However, in the fourth limitation of the claim the language seems to require dining establishments, lodging, etc. So which is it? It has been assumed for examination that they are not all required in the invention. Claim 26 has the same problem with clarity because of these limitations.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Broadhead whose telephone number is 571-272-6957. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached on 571-272-6956. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications and (571) 273-8300 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600.

BJB  
May 15, 2007

*Paul Brundage*  
*BB*